

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. :	10/064,104)	Confirm. No. 9166
)	
Appellant :	Trese J. Vackar)	
)	
Filed :	June 11, 2002)	
)	
TC/Art Unit :	3732)	
)	
Examiner :	Stephanie L. Willatt)	
)	
Docket No. :	TVAC.01P)	
)	
Cust. No. :	23732)	
)	

AMENDED BRIEF ON APPEAL

Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REAL PARTY IN INTEREST

Appellant is the real party in interest.

RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 1-13 have been finally rejected and are the subject of this appeal. Claims 14-17 have been allowed.

STATUS OF AMENDMENTS

An AMENDMENT AFTER FINAL was filed on April 14, 2005, to correct an informality in the specification that was first noted by the Examiner in the November 17, 2004, "final" action.

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SUMMARY OF THE CLAIMED SUBJECT MATTER

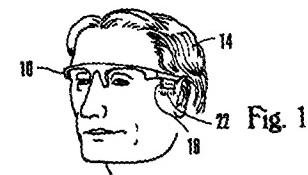
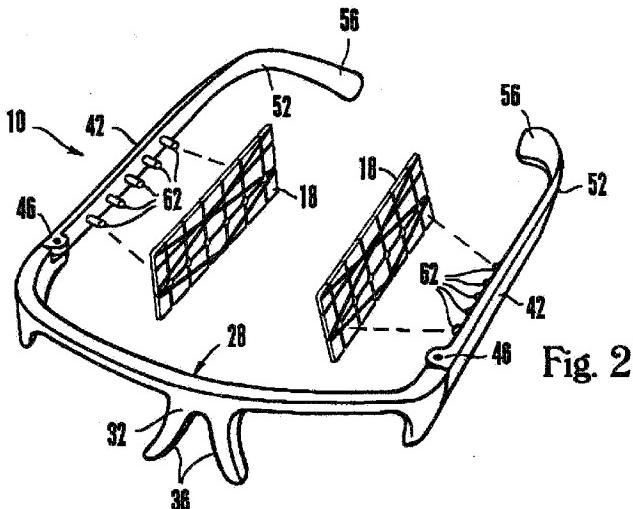
Introduction

Prior to the invention of the safety razor by King Gillette, circa 1900, most men elected to wear facial hair during their adult lives. The low-cost safety razor, and, later, the availability of electric razors, permitted most men to easily and inexpensively sport a clean-shaven look - with sideburn length dictated by current fashion.

The trimming of sideburns remains somewhat difficult, since each must individually be trimmed. Stencils, patches, and embossed printing devices have been suggested, and over time, most have been found to be awkward to use, difficult to align, and sometimes uncomfortable to remove.

Figure 2 is reproduced herein, showing a trim guide 10 having a front face frame 28 with a centrally-located bridge 32 with a pair of opposed nose pads 36. A pair of temples 42 extend back from the front face frame 28, with a bend 52 formed therein defining a pair of earpieces 56.

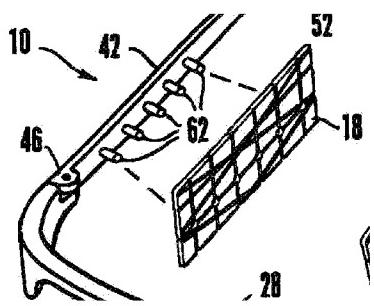
The bend 52 and the earpiece 56 are configured for reception about the upper and rear exterior surfaces lying at the base of a user's ear. Likewise, the opposed pair of nose pads 36 are shaped to conform to the outer, upper surfaces of a



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human nose. In this manner the trim guide 10 is enabled to be received upon the nose and ears of the user 14 (see Figure 1, above) in much the same stable manner as a pair of eyeglasses.

Along an inner surface of each of the temples 42 are formed



a plurality of projecting support pegs 62. Preferably equally spaced along the temple 42, the plurality of support pegs 62 provide a place of attachment 18 for a trim gauge 18 - each of which have a plurality of support apertures 66 formed therein (see Specification, Paragraphs [0019]- [0021]).

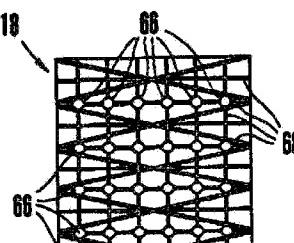


Fig. 3

Independent Claim 1 includes:

(a) an eyeglass frame having a front face frame and a pair of temple pieces attached to and extending rearwardly from said front face frame;

(b) each of the pair of temple pieces biased inwardly and having a portion thereof resting upon an ear of a user, when said eyeglass frame is positioned for use by said user; and

(c) a trim guide selectively pegged to said eyeglass frame.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) Claims 1-2 and 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin (U.S. Patent No. 3,613,694) in view of Miller (U.S. Patent No. 4,106,515); and

(2) Claims 3-7 and 11-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin (U.S. Patent No. 3,613,694) in view of Miller (U.S. Patent No. 4,106,515) as

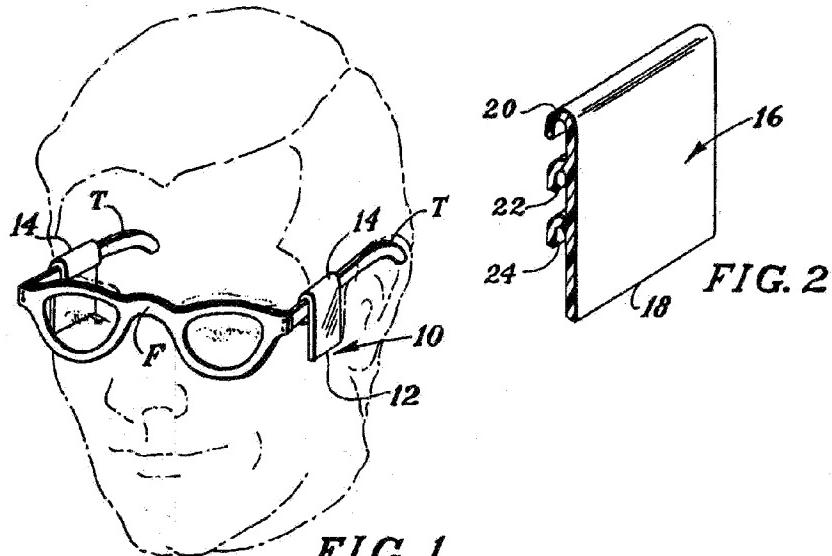
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applied to Claims 1-2 and 8-10, above, and in further view of Sessoms (U.S. Patent No. 1,385,722).

THE ARGUMENT

(I.) Whether Claims 1-2 and 8-10 are unpatentable under 35 U.S.C. §103 over Benjamin in view of Miller, as set forth in the rejection of paragraph 3 of the November 17, 2004, Office Action?

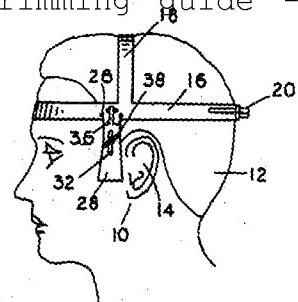
Benjamin (U.S. Patent No. 3,613,694) discloses an eyeglasses sideburn



trimmer, and the Examiner correctly identifies the lack in Benjamin of a "pegs" disclosure.

The Examiner offers Miller as providing the missing teaching for the use of pegs in a side burn trimming guide - specifically, on page 3 of the Action:

Miller discloses a peg (shaft 24) attached to a frame and projecting therefrom so it can fit through an aperture (slit 32) of a trim guide



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(template 28), as discussed in column 2, lines 7-23.

The structure identified as a peg or shaft is in fact a threaded shaft. Completion of the Miller fastening unit requires:

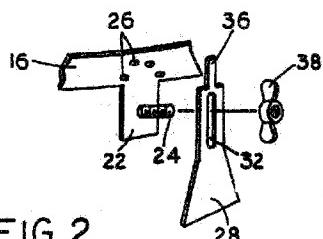


FIG. 2

Means 38 such as an internal threaded nut or a wing nut are provided to lock the template 28 about the shaft 24. (Col. 2, Lines 22-24).

Use of a true "peg" (i.e., "a small cylindrical or tapered pin" - see claim interpretation discussion beginning on page *, herein), would present problems to the Miller side burn trimmer. A peg - template interengagement is slideable in nature, and would permit the template 28 to freely slide the vertical length of the slit 32. Such a replacement would render the Miller device "unsatisfactory for its intended purpose" of providing "an even and accurate cut" of a user's side burns.

A key attribute of the Miller templates 28 is their slit 32 that, in combination with the threaded shaft 24 and retaining nut 38, permit easy adjustment in side burn length. In such a combination, a peg might enable easy adjustment, but without being able to secure its relative position along the slit 32, such a peg would offer no assurance of maintaining an accurate measurement.

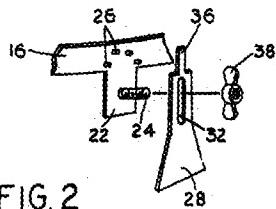


FIG. 2

Section 2143 of the Manual of Patent Examining Procedure ("M.P.E.P.") identifies three requirements to establish a prima facie case of obviousness: (1) some suggestion or motivation to modify or combine the reference(s); (2) a reasonable expectation

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of success; and (3) the prior art reference(s) must teach or suggest all claim(s) limitations. The overriding rational for all three limitations is to avoid the temptation of a hindsight analysis.

Section 2143.01 of the M.P.E.P. and In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) both caution that when a proposed modification of a prior art invention would render the invention being modified unsatisfactory for its intended purpose; there can be no suggestion or motivation to make the proposed modification.

Accuracy is key to Miller (as well as to all side burn trimming guides), and thus to so modify Miller would destroy its primary intended purpose. Under such circumstances, such a proposed modification of Miller is not proper, and the prima facie case of obviousness can not be properly made.

In the FINAL Office Action of November 17, 2004, the Examiner responded to the above argument by stating in Paragraph 6:

[T]he claims do not specify whether or not the peg is threaded. Further, the dictionary definition of "pegged" is "to fasten with a peg". The peg (24) in Miller, although threaded and in combination with nut (38) meets the broad definition of "pegged" as well as the broad claim language of the present application.

The Examiner's justification appears to rely upon a style of claim interpretation that is somewhat (!) circular. The relevant language of Claim 1 is:

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a trim guide selectively pegged to said eyeglass frame.

Appellant has no quarrel with the Examiner's definition of "pegged" as: "to fasten with a peg." Appellant submits, however, that it is improper to label the Miller "Means 24 such as a threaded shaft" (Column 1, line 67) as a "peg."

The construction of patent claims has been in turmoil following a series of conflicting Federal Circuit opinions. Recognizing the problem, the Federal Circuit agreed to a rehearing en banc in the Phillips v. AWH Corp. case. Oral argument was held on February 8, 2005, and it is Appellant's understanding that no decision has yet been handed down. Among the issues briefed: should dictionaries or the patent specification be the primary source for claim construction.

It is Appellant's understanding that the Patent Office position favors the patent specification as the primary reference for claim construction. As discussed in considerable detail under the "Summary" section of the present Brief, Appellant has clearly and unambiguously identified the structure referred to as support pegs 62. This structure is also consistent with the provisions of Specification Paragraph [0014] under the "Summary of the Invention" section:

A plurality of holes and pegs are provided to enable a range of adjustments to obtain the desired hair and sideburn lengths. [Portions omitted.] The snap-on manner of attaching the guides provides for positive placement of the

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guide - yet with the ability to easily change position of the guide as may be later required.

This manner of use of the term "peg" within Appellant's specification is entirely consistent with general purpose dictionaries, such as Merriam-Webster OnLine and The American Heritage® Dictionary (copies attached in EVIDENCE APPENDIX):

- 1a. A small cylindrical or tapered pin, as of wood, used to fasten things or plug a hole.

The meaning and structure of Appellant's "peg" is clearly and consistently stated within the specification, as well as being in conformance with the commonly-understood meaning of that term.

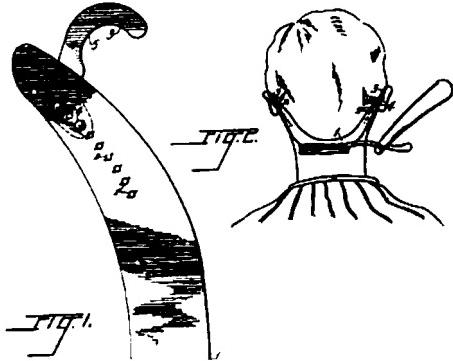
It is respectfully submitted that the Examiner's effort to "morph" this structure into a threaded shaft is based solely on a hindsight effort to construct Appellant's claimed invention out of the teachings of Benjamin and Miller. As set forth above, a prima facie case of obviousness has not been made, and a withdrawal of the Section 103 rejection is respectfully requested.

(II.) Whether Claims 3-7 and 11-13 are unpatentable under 35 U.S.C. §103 over Benjamin in view of Miller (as applied above), and in further view of Sessoms, as set forth in the rejection of paragraph 4 of the November 17, 2004, Office Action?

Claims 3-7 and 11-13 are either directly or indirectly dependent from Claim 1. As discussed in the previous subheading, the combination of Benjamin and Miller fails to make a prima facie case of obviousness. The additional teaching of

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Sessoms, (U.S. Patent No. 1,385,722) relating to the provision of multiple holes 2 in a neck shaving guide strip 1 for adjustability of the latter, does not supply the motivation and claim limitations that are otherwise missing from the Examiner's prior art Benjamin and Miller combination rejection under §103. A withdrawal of the Section 103 rejection is respectfully requested.



CONCLUSION

For the reasons advanced in the foregoing argument, Appellant respectfully contends that independent Claim 1 and dependent Claims 2-13 are patentable. Reversal of all rejections is courteously solicited.

Respectfully submitted,

KENEHAN & LAMBERTSEN, LTD.

Dated: 17 June 2006

By:


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CLAIMS APPENDIX

1. A hair trim guide comprising:

an eyeglass frame having a front face frame and a pair of temple pieces attached to and extending rearwardly from said front face frame, each of the pair of temple pieces biased inwardly and having a portion thereof resting upon an ear of a user when said eyeglass frame is positioned for use by said user; and

a trim guide selectively pegged to said eyeglass frame.

2. A hair trim guide according to Claim 1, and further comprising:

at least one peg attached to said eyeglass frame and projecting therefrom, wherein said trim guide having at least one aperture formed therein.

3. A hair trim guide according to Claim 2, wherein said trim guide has a plurality of apertures formed therein.

4. A hair trim guide according to Claim 3, wherein said plurality of apertures of said trim guide are configured in an array.

5. A hair trim guide according to Claim 4, wherein said plurality of apertures of said trim guide are configured in a vertical array.

6. A hair trim guide according to Claim 3, wherein at least a pair of pegs are attached to said eyeglass frame, at least one peg of said at least a pair of pegs is attached to and projects from each of said pair of temple pieces.

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7. A hair trim guide according to Claim 6, wherein a plurality of pegs are attached to and project from each of said pair of temple pieces.

8. A hair trim guide according to Claim 4, wherein said trim guide is frangible.

9. A hair trim guide according to Claim 8, and further comprising a plurality of cut line inscribed in said trim guide.

10. A hair trim guide according to Claim 9, wherein said cut lines extend vertically, horizontally, and on a bias.

11. A hair trim guide according to Claim 1, and further comprising at least a pair of pegs attached to said trim guide and projecting therefrom, wherein said eyeglass frame having at least a pair of apertures formed therein.

12. A hair trim guide according to Claim 11, wherein a plurality of pegs are attached to and project from said trim guide.

13. A hair trim guide according to Claim 12, wherein said plurality of pegs attached to said trim guide are configured in a pair of vertical arrays.

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EVIDENCE APPENDIX

Merriam-Webster OnLine

Merriam
Webster

Merriam-Webster FOR KIDS

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Merriam-Webster Online Dictionary

[Thesaurus](#)

11 entries found for peg. The first 10 are listed below.
To select an entry, click on it. For more results, [click here](#).

peg[1,noun]
 peg[2,verb]
 peg[3,adjective]
 clothes-peg
 mumblety-peg
 off-the-peg

Main Entry: ¹peg

Pronunciation: 'peg

Function: *noun*

Etymology: Middle English *pegge*, probably from Middle Dutch

1 a : a small usually cylindrical pointed or tapered piece (as of wood) used to pin down or fasten things or to fit into or close holes : [PIN](#), [PLUG](#) b *British* : [CLOTHESPIN](#) c : a predetermined level at which something (as a price) is fixed

2 a : a projecting piece used as a support or boundary marker b : something (as a fact or opinion) used as a support, pretext, or reason

3 a : one of the movable wooden pegs set in the head of a stringed instrument (as a violin) that are turned to regulate the pitch of the strings -- see [VIOLIN](#) illustration b : a step or degree especially in estimation

4 : a pointed prong or claw for catching or tearing

5 *British* : [DRINK](#) <poured himself out a stiff peg -- Dorothy Sayers>

6 : something (as a leg) resembling a peg

7 : [THROW](#); *especially* : a hard throw in baseball made in an attempt to put out a base runner

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Pegasus >

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The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

peg

PRONUNCIATION: pēg

NOUN: 1a. A small cylindrical or tapered pin, as of wood, used to fasten things or plug a hole. b. A similar pin forming a projection that may be used as a support or boundary marker. 2. *Music* One of the pins of a stringed instrument that are turned to tighten or slacken the strings so as to regulate their pitch. 3. A degree or notch, as in estimation: *Our opinion of him went up a few pegs after he did the dishes.* 4. *Chiefly British* A drink of liquor. 5. *Baseball* A low and fast throw made to put a base runner out. 6. *Informal* A leg, especially a wooden one.

VERB: Inflected forms: pegged, peg·ging, pegs

TRANSITIVE VERB: 1. To fasten or plug with a peg or pegs. 2. To designate or mark by

means of a peg or pegs. 3. To fix (a price) at a certain level or within a certain range. 4. *Informal* To classify; categorize: *I pegged her as an opportunist. Why do you have me pegged as the rowdy one?* 5. *Informal* To throw.

INTRANSITIVE VERB: To work steadily; persist: *pegged away until our luck turned.*

IDIOM: **take (someone) down a peg** To reduce the pride of; humble.

ETYMOLOGY: Middle English *pegge*, from Middle Dutch.

LA

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SA

FR
SH
OV

RE

LA

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EVIDENCE APPENDIX - PAGE 14

11 No. 23 Andrews Intell. Prop. Litig. Rep. 4

Andrews Intellectual Property Litigation Reporter
March 3, 2005

Claim Construction

FED. CIRCUIT HEARS ARGUMENT ON ROLE OF DICTIONARIES IN CLAIM CONSTRUCTION

Phillips Corp. v. AWH Corp.

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The Federal Circuit, sitting en banc Feb. 8, heard oral arguments to resolve certain issues concerning the construction of patent claims and the use of dictionaries in interpreting claim terms.

Phillips Corp. v. AWH Corp., Nos. 03-1269 and 03-1286, oral argument held (Fed. Cir. Feb. 8, 2005). The U.S. Court of Appeals for the Federal Circuit asked the parties to brief several issues, including whether dictionaries or the patent specification should be the primary source for claim construction, or whether both should be used and, if so, in what order.

The court also asked the parties to address whether a claim should be narrowly construed for the sole purpose of avoiding invalidity, what the role of prosecution history and expert testimony should be in claim construction, and what, if any, level of deference should be given to the claim construction rulings of the U.S. District Court for the District of Connecticut. See Phillips v. AWH Corp., 376 F.3d 1382, 1383 (Fed. Cir. 2004).

The battle before the court stems from a dispute between Phillips Corp. and AWH Corp. over Phillips' U.S. Patent No. 4,677, 798 for vandalism-resistant wall panels.

As explained by Paul Derwinsky, a partner at McDermott Will & Emery in Washington D.C., the question of claim construction is frequently dispositive of litigation involving patents. Thus, the choice of a methodological approach to construing claim terms will directly affect the litigation results, he said.

Derwinsky said, however, that the panel decisions of the Federal Circuit, have been inconsistent, using various methodological approaches to construing claim terms. One such approach is to use dictionaries as a primary reference for construing a claim term. Another approach is to rely primarily on the patentee's own specification. Currently, patent infringement litigation is often unpredictable because of the panel's inconsistent approaches and decisions, he said.

Bonnie J. Warren, an associate at McDermott, attended the oral argument before the Federal Circuit. She reported that during oral arguments, Phillips suggested that the specification should be consulted first and then the patent claims be read to gauge whether the claims are broader than the disclosures in the written description. Thereafter, a general-purpose dictionary should be consulted for ordinary terms and a technical dictionary or treatise should be consulted for terms of art, the company said. Phillips indicated that the claims should not be narrowed unless there is a clear disavowal of claim scope or explicit language in the specification that narrows the claims.

When the circuit court asked whether any deference should be given to the District Court's claim construction rulings, Phillips argued that deference should be given to the District Court's findings of fact, such as the nature of one of ordinary skill in the art, which dictionary should be consulted and the credibility of expert witnesses.

AWH argued that the specification should be the primary source for claim construction. AWH suggested that if the specification implies that a claim element is narrow, then it should be so construed.

In response to the court's questioning how a judge would decide if there is an implicit narrowing, AWH suggested that if a claim element is essential to the invention, but is not explicitly described in the specification, then the scope of the claim element should be narrowed or limited to what is disclosed in the specification.

AWH also argued that it is wrong to allow claims to be granted that are broader than what is taught to the public.

In response to the circuit court's question on whether any deference should be given to the District Court's claim construction rulings, AWH argued that deference should be given only to the District Court's findings of fact.

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The U.S. Patent and Trademark Office took the position that dictionaries should not be a primary reference for claim construction, in part because they are not used by examiners during prosecution. The PTO did not articulate a clear position in response to the court's question on whether any deference should be given to the District Court's claim construction rulings.

Derwinsky said that patent prosecutors and litigators alike await the Federal Circuit's resolution of the issues presented in Phillips, with the hope that the court will clarify the inconsistent panel decisions and provide clear guidance on the proper approach to construing patent claims.

Company: AWH Corp.

END OF DOCUMENT

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RELATED PROCEEDING(S) APPENDIX

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None.

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RELATED PROCEEDING(S) APPENDIX